



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/432,869	11/02/1999	STEVEN W. BROWN	APPL-P2840	1715

7590 03/18/2003

JONATHAN VELASCO  
SIERRA PATENT GROUP  
P O BOX 6149  
STATELINE, NV 89449

EXAMINER

RAY, GOPAL C

ART UNIT	PAPER NUMBER
----------	--------------

2181

DATE MAILED: 03/18/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/432,869**

Applicant(s)  
**Brown**

Examiner  
**Gopal C. Ray**

Art Unit  
**2181**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 18, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2181

1. Claims 1-11 are presented for examination.
2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admitted prior art in view of US Patent 5,809,331 issued to Staats et al.

As per claim 1, applicant's admitted prior art teaches "creating a configuration ROM image for each link device; and presenting said configuration ROM image for each said link device" in Fig. 2, element 7 and page 4, lines 9-20.

Applicant's admitted prior art fails to teach "an individual configuration ROM image for each link device". However, the above feature was well known to one of ordinary skill in the art at the time the invention was made as evidenced by Staats et al. The reference of Staats et al. teaches the feature in Fig. 2, element 50 and col. 4, lines 53-61. One of ordinary skill in the art at the time the invention was made would have realized that it is important to have an individual configuration ROM image for each link device for reliable operation of the computer system

Art Unit: 2181

because that will match the proper driver to the proper device efficiently. The reference of Staats teaches that in col. 1, lines 37-54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the applicant's admitted prior art to implement the above feature of Staats because that would make the applicant's admitted prior art system's operation more reliable.

As per claim 2, applicant's admitted prior art teaches "said configuration ROM image includes an entry for a distinct identifier for a corresponding link device" in Fig. 2, elements 5a, 5b and page 4, lines 9-20.

As per claim 3, applicant's admitted prior art teaches the added feature in Fig. 2, element 7 and page 4, lines 9-20.

As per claim 4, applicant's admitted prior art teaches "Wherein said creating and presenting said configuration ROM image is carried out by transaction layer software" in Fig. 2, element 6 and page 5, lines 13-16.

As per claims 5 and 6, the claims recite apparatuses which parallel method claims 1 and 2 respectively. In teaching the construction and use of the device, the combination of applicant's admitted prior art and US Patent 5,809,331 issued to Staats et al. teaches corresponding apparatuses.

Art Unit: 2181

As per claims 7 and 8, the claims are rejected for similar reasons as discussed in the rejection of claims 5 and 6 respectively.

As per claims 9-11, the claims are rejected for similar reasons as discussed in the rejection of claims 1-3 respectively with the exception of "a program storage device readable by a machine, tangibly embodying a program of instruction executable by the machine to perform the method". However, applicant's admitted prior art teaches the feature on page 4, lines 16-17.

4. Applicant's arguments filed on 12/18/02 have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, e.g., "... multiple subunits (referred to as "nodes" in the present application..." are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Fig. 1 of US Patent 5,809,331 shows two nodes 14 and 15 in module 10. The invention as claimed reads on the applicant's admitted prior art (Fig. 2) with the exception of "an individual configuration ROM image for each link device or node". The secondary reference is used to show that it is within the skill

Art Unit: 2181

of an ordinary person at the time of the invention to modify a system install an individual configuration ROM image for each link device or node. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Moreover, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

Art Unit: 2181

statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone numbers for this Group are (703) 746-7238 for "After-final", (703) 746-7239 "official" and (703) 746-7240 for "Non-official/Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**mark.rinehart@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Serial Number: 09/432,869

Page 7

Art Unit: 2181

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.

*Gopal C. Ray*  
**GOPAL C. RAY**  
**PRIMARY EXAMINER**  
**GROUP 2800**